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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/904,299	07/31/1997	ROBERT M. LUNDBERG		3733

7590 03/01/2007
PAUL L BROWN
EMRICH AND DITHMAR
SUITE 3000
300 SOUTH WACKER DRIVE
CHICAGO, IL 60606

EXAMINER

KAMEN, NOAH P

ART UNIT	PAPER NUMBER
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3747

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/01/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

08/904,299

Applicant(s)

LUNDBERG, ROBERT M.

Examiner

Noah Kamen

Art Unit

3747

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2001.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 9-12 and 16-22 is/are pending in the application.
- 4a) Of the above claim(s) 9 and 17-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 10-12, 15, 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

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DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 9-12, 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grennan (fig.2).

Grennan shows all of the recited elements except the capacity of the generator 166. Sizing the generator would have been obvious to one of ordinary skill in the art according to the supply system size and the degree of peak capacity. Furthermore, the use of gauges, valves and appropriate controls are inherently necessary for the proper operation of Grennan.

Response to Arguments

Applicant's arguments filed 7/13/01 have been fully considered but they are not persuasive.

The applicant comments that Grennan compresses gas during off peak electricity utilization, that the distribution lines are not satellites, that the expansion and compression trains are both coupled to motor/generator 166, usage of motors and generators to control the compression stage of a system as well as the utilization of shafts and clutches is antithetical to the claimed invention because it results in expensive generation of electricity and fuel losses, that the compression is limited in time and the generation functions can operate only when the compressing section is shut off.

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The examiner contends that the claims do not prohibit the compression of gas during off peak utilization and the usage of motor/generator with clutches to control the compression stage. The arguments of the compression being limited in time and the generation function operating when the compressing section is shut off are not germane to the claims. Grennan clearly indicates that there are a number of distribution lines connected to the transmission line. Each distribution line is connected via the expansion/compression system. The mere recitation of "satellites" is broad enough to read on the distribution lines.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Noah Kamen whose telephone number is 703 308 1945. The examiner can normally be reached on M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Yuen can be reached on 308 1946. The fax phone numbers for the


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organization where this application or proceeding is assigned are 703 746 4547 for regular communications and 308 7766 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308 0861.


Noah Kamen
Primary Examiner
Art Unit 3747

nk
July 26, 2001



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JUN 26 2006

OFFICE OF PETITIONS

ON PETITION

In re Application of
Robert M. Lundberg
Application No. 08/904,299
Filed: July 31, 1997
Attorney Docket No: 101AB

This is a decision on the petition filed February 25, 2002 by facsimile transmission and followed up with hard copy March 11, 2002 filed by first class mail. The petition seeks to have the abandonment withdrawn and is thus treated under 37 CFR 1.181, in accordance with the reasoning of the decision in Delgar Inc. v. Schuyler, 172 USPQ 513.

The petition is **GRANTED**.

This application became abandoned on October 28, 2001, for failure to file a timely response to the Final Office Action mailed July 27, 2001, which set a three (3) month statutory period for reply. The instant petition and this decision precede the mailing of the Notice of Abandonment.

Petitioner asserts that the Final Office Action was never received.

Although, all documents filed by the applicant always listed the correspondence address as PAUL L BROWN, EMRICH AND DITHMAR, SUITE 3000, 300 SOUTH WACKER DRIVE, CHICAGO, IL 60606, a data entry error on the part of the USPTO entered the address with a suite number of "300" instead of "3000". And, although all correspondence from the USPTO to the applicants always bore an incorrect suite number, applicants always seemed to receive the mail even with the incorrect address on it. However, petitioners should not have to bear the brunt of the errors caused by the USPTO and thus, in view of the facts set forth in the petition, it is concluded that the Office Action was incorrectly addressed and never received at the address of record. Accordingly, the holding of abandonment is withdrawn and no petition fee is due.

The address has been corrected to include the correct suite number.

This matter is being referred to Technology Center 3747 for a re-mailing of the Final Office Action and for a restarting of the period for response.

Telephone inquiries concerning this matter should be directed to the undersigned Petitions Attorney at (571) 272-3212.

A handwritten signature in cursive script that reads "Patricia Faison-Ball". The signature is written in dark ink and is positioned above the printed name and title.

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions